IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Paul A. Flaherty
Application No.	:	10/022,149
Filing Date	:	December 14, 2001
Art Unit	:	3621
Title	:	RETAIL COUPON DISTRIBUTION APPARATUS AND METHOD
Attorney Docket No.	:	5598/44 US

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APPEAL BRIEF

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I. REAL PARTY IN INTEREST

The real parties in interest in this Appeal are: the Assignee of the present application, Overture Services, Inc., which is a division of Yahoo! Inc.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1-32 are pending in this application. The Examiner has rejected all of these claims. Claims 1-32 as amended during prosecution are reproduced in Appendix A attached hereto. Applicant is appealing the rejections of Claims 1-32.

IV. STATUS OF AMENDMENTS

Applicant did not file any amendments subsequent to the Examiner's final rejection that was mailed on April 21, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1 describes a communication application that is executable on a network (*e.g.*, 512, 524, 526, 528). To the extent that any of the elements in any of the claims comply with the requirements of 35 U.S.C. §112, paragraph 6, at lest some of the structures, corresponding to the claimed functions, are referenced. The application includes a client process that is executable on a processor in a two-way communication device. (*See, e.g.*, page 10, lines 3-6.) The two-way communication device has a display screen, capable of displaying a barcode image that is suitable for scanning by a barcode scanner. (*See, e.g.*, Figure 4 and 820 in Figure 8.) In other words, the barcode image is capable of modulating a laser in motion, such as a laser used in a retail barcode scanning device. (*See, e.g.*, page 5, lines 20-24.) The claimed application also includes a server process that is executable on a processor communicatively

coupled over the network with the client process. (*See, e.g.*, page 7, line 17 – page 8, line 16; page 11, lines 14-26.) A coupon depository is coupled to the server process and is capable of storing a plurality of coupons. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The coupons are encoded with a barcode image. (*Id.*) The server process sends a particular coupon to the client process. (*See, e.g.*, page 7, line 17 – page 8, line 16; page 11, lines 14-26.) The client process decodes the respective barcode image corresponding to the respective coupon, and displays the respective barcode image on the display screen. (*See, e.g.*, page 4, lines 10-19; page 15, line 1 – page 18, line 27.)

Independent Claim 10 describes another communication application. This application is executable on a network (*e.g.*, 512, 524, 526, 528) and is communicatively coupled to a server process. The application includes a client process executable on a processor in a two-way communication device. (*See, e.g.*, page 10, lines 3-6.) The two-way communication device includes a display screen, capable of displaying a barcode image suitable for scanning by a barcode scanner. (See, *e.g.*, Figure 4 and 820 in Figure 8.) The client process has an interactive input process capable of receiving input signals from the two-way communication device. (*See, e.g.*, page 4, line 20 – page 5, line 2; page 9, line 5 – page 13, line 30.) The client process also has a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network. (*Id.*) The client process also has a communication receiving process responsive to communication signals from the server process for receiving coupon information from the server process. (*Id.*) The coupon information includes an encoded barcode image. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The client process also includes a display process responsive to

the receipt of the coupon information for decoding the encoded barcode image and displaying the barcode image. (*See, e.g.*, page 4, lines 10-19; page 15, line 1 – page 18, line 27.)

Independent Claim 16 describes another communication application. It is executable on a network (*e.g.*, 512, 524, 526, 528). This application includes an electronic coupon clearinghouse that is coupled to the network and that contains a plurality of electronic coupons. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The electronic coupons include encoded barcode images. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) A coupon database is coupled to the electronic coupon clearinghouse. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) A server is coupled to the network and is capable of accessing the electronic coupon clearinghouse and receiving electronic coupons from the clearinghouse. (*Id.*) The application further includes a two-way communication device. (*See, e.g.*, page 10, lines 3-6.) The device is capable of communicating on the network and receiving electronic coupons from the server via the network. (*See, e.g.*, page 4, lines 10-19; page 10, lines 3-6; page 15, line 1 – page 18, line 27.) The two-way communication device is also capable of decoding the encoded barcode images and displaying the barcode images on a screen display. (*Id.*)

Independent Claim 23 of the present application describes a system for providing a user of a two-way communication device with an electronic coupon. The device may be, for example, a cellular telephone (510), pager (520) or a hand-held computer (511), *e.g.*, a personal digital assistant (PDA) or a palm-held computing device. The system includes a network (*e.g.*, 512, 524, 526, 528), a server, a coupon depository and a two-way communication device. The two-way communication device is connected to and is part of the network. In addition, the two-way communication device has a display. (*See, e.g.*, Figure 4 and 820 in Figure 8.) The server

is also connected to and is part of the network. (*See, e.g.*, page 7, line 17 – page 8, line 16; page 11, lines 14-26.) The coupon depository is connected to the server and stores a plurality of coupons. At least some of the coupons have an associated barcode image. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The server is effective to forward select coupons and associated barcode images to the two-way communication device. (*See, e.g.*, page 7, line 17 – page 8, line 16; page 11, lines 14-26.) The two-way communication device is effective to receive the select coupons and images and display the barcode images on its display. (*See, e.g.*, page 4, lines 10-19; page 15, line 1 – page 18, line 27.)

Independent Claim 28 of the present application describes a method for providing a user of a two-way communication device in a network (*e.g.*, 512, 524, 526, 528) with an electronic coupon. The network includes a server connected to a coupon depository. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The coupon depository stores a plurality of coupons. (*Id.*) At least some of the coupons include an associated barcode image. (*See, e.g.*, page 3, lines 19-23; page 4, lines 13-14; page 5, lines 5-6; page 6, lines 13-20.) The two-way communication device has a display. (*See, e.g.*, Figure 4 and 820 in Figure 8.) One of the steps in the method is to forward selected coupons and associated barcode images to the two-way communication device from the server. (*See, e.g.*, page 7, line 17 – page 8, line 16; page 11, lines 14-26.) Another step is to receive the coupons and images at the two-way communication device. (*See, e.g.*, page 4, lines 10-19; page 15, line 1 – page 18, line 27.) Another step is to display the barcode images on the two-way communication device's display. (*Id.*)

These applications, system and method can be used in a number of manners. For example, a user can enter a particular product into a two-way communication device, which will

then transmit the data to a server. Upon receipt, the server will determine whether a coupon for the particular product is available and if yes, transmit the coupon to the two-way communication device. (*See, e.g.*, page 3, lines 14-23; page 6, line 19 – page 7, line 10.) Another example is when a user transmits a generic type of product instead of a specific product. In response, the server will send a catalog of coupons that correspond to the generic type of product. (*See, e.g.*, page 3, lines 24-28; page 6, line 19 – page 7, line 10.) Another example is a user may subscribe to a coupon service where coupons that match a user's profile are sent to the user on a scheduled basis. (*See, e.g.*, page 4, lines 1-6; page 6, line 19 – page 7, line 10.) Another example is the location of the two-way communication device is tracked by, for example, global positioning information and the coupons delivered to the device are coupons for a product that are of interest to a user based on her profile and that are distributed by a retailer in her vicinity. (*See, e.g.*, page 7, lines 11-16.) In all of these applications, upon receipt of a coupon, the user will cause the barcode associated with the coupon to be displayed on the two-way communication device and can hand the two-way communication device to a retail clerk so that the barcode can be scanned. (*See, e.g.*, page 4, lines 7-9.)

VI. Grounds Of Rejection To Be Reviewed On Appeal

The issues for review in this appeal arise from a Final Rejection that was mailed on April 21, 2004. The Examiner rejected claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,542,750 ("Hendrey") in view of U.S. Patent No. 6,135,354 ("Kubon"). Therefore, the issues in this appeal are:

1. Whet her Hendrey in view of Kubon, individually or in combination, discloses or suggests all the elements of the following claims:

    a. Claims 1-9,

b. Claims 10-15,

c. Claims 16-22,

d. Claims 23-27, and

e. Claims 28-32.

2. Whether Hendr ey or Kubon contain a motivation to combine one reference with the other reference?

VII. ARGUMENT

The Board should reverse the Examiner's rejections since they are incomprehensible and unsupported. The Examiner rejected Claims 1-32 under 35 U.S.C. § 103 as being unpatentable over Hendrey in view of Kubon. The Examiner argued Hendrey explicitly discloses almost all of the claim elements and Kubon discloses the elements not disclosed by Hendrey. The Examiner also argued a person of ordinary skill in the art would have known to combine the two references to arrive at the claimed inventions. However, the Examiner fails to recognize that the references do not disclose all of the elements of any of the independent claims and, even in combination, the two references do not yield the claimed inventions. Furthermore, neither reference contains a motivation to combine one disclosure with the other disclosure and the Examiner fails to provide any evidence to the contrary. In addition, The Examiner fails to support his conclusion. Accordingly, the Board must reverse the Examiner's rejections.

A. The Examiner's Rejections

The Examiner rejected Claims 1-32 under 35 U.S.C. § 103(a) as being unpatentable over Hendrey in view of Kubon. The Examiner stated Hendrey substantially discloses all the elements of these claims except a display screen capable of displaying a barcode image. The Examiner asserts that Kubon describes a barcode image processing system that processes video signals including video data representing images of barcode labels to be decoded

and verified. Then, without explanation, the Examiner jumps to the conclusion that the image data displayed on a video camera can be displayed on a telephone. He also argues, without explanation, one of ordinary skill in the art would have known to modify the telecommunications system of Hendrey with the aforementioned teaching of Kubon because "such modification would verify and report unauthorized users within the telecommunication network." (Office Action mailed April 21, 2004, ¶ 5, page 3.)

B. The Examiner's Rejections of the Claims Should be Reversed Since Hendrey and Kubon, Individually or In Combination, Fail to Disclose All the Elements of the Claims

1. Claims 1-9

Hendrey and Kubon, individually or in combination, do not disclose all the elements of Claims 1-9 as argued by the Examiner. Starting with Hendrey and Claim 1, the claim describes "a communication application executable on a network comprising:"

> [A] client process executable on a processor in a two-way communication device, the two way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner;
>
> a server process executable on a processor communicatively coupled over the network to the client process; and
>
> a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image, the server process including an operation of sending a particular coupon to the client process, the client process including an operation for decoding the respective barcode image encoding corresponding to the particular coupon and displaying the respective barcode image on the display screen.

Hendry does not disclose all these elements. For example, one element of Claim 1 is, "the coupons including an encoding of a barcode image." Hendrey does not refer to barcodes and therefore can not disclose this element. In addition, Hendrey's reference to e-coupons (*see*,

Section B.1, *supra*) does not disclose this element. Moreover, Hendrey contains no suggestion that e-coupons be combined with barcodes. Furthermore, the Examiner has acknowledged that Hendrey does not disclose a coupon including a barcode image. (*See*, Office Action mailed April 21, 2004, at ¶ 7.1, p. 7.) Therefore, Hendrey does not disclose nor suggest "the coupons including an encoding of a barcode image" of Claim 1.

The Examiner also incorrectly argues that Hendrey discloses a "coupon depository" by referencing Column 15, lines 30-53. Instead, this passage describes a database 143 that contains locations of historical, cultural or other importance, such as particular types of restaurants, coffee shops, snack shops or other businesses. (*See*, column 15, lines 35-37, 47-48; Figure 8.) Hendrey does not specify database 143 is a depository coupled to a server process and capable of storing a plurality of coupons. Hendrey's reference to e-coupons being sent to a mobile user does not provide the missing disclosure especially since the rest of Hendrey does not specify where the e-coupons are stored. (*See*, column 15, lines 41-46.) Moreover, Hendrey does not suggest the e-coupons are stored in database 143 or in any other database described in Hendrey. Therefore, Hendrey does not disclose nor suggest "a coupon depository coupled to the server process capable of storing a plurality of coupons" as described in Claim 1.

The Examiner further incorrectly argues that Hendrey discloses a "client process." Claim 1 describes the "client process" as:

> [A] client process executable on a processor and a two-way communication device, the two-way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner...

The Examiner states this element is described in Hendrey (*i.e.*, Abstract; Figure 1; Column 2, lines 40-67; Column 5, lines 26-67; Column 6, lines 1-67, specifically MUs 101a-c). However, Hendrey does not contain any such description for several reasons. First, Hendrey's references

to mobile telecommunication units (MUs) and telecommunication units (TUs) illustrates that they can be a mobile telephone, a personal digital assistant, a land line telephone and a personal computer. (*See, e.g.*, Figures 1 and 8.) However, these brief descriptions do not disclose nor suggest a two-way communication device that includes a display screen capable of displaying a barcode image suitable for scanning via a barcode scanner. The lack of any reference to barcodes in Hendrey confirms this fact. Moreover, Claim 1 contains an additional description of the "client process" not disclosed by Hendrey:

> [T]he client process including an operation for decoding the respective barcode imaging coding corresponding to the particular coupon and displaying the respective barcode image on the display screen.

Since the Examiner fails to cite any portion of Hendrey that describes this claim element, Hendry can not disclose nor suggest the "client process" described in Claim 1.

Similarly, the Examiner erroneously states that Hendrey discloses the "server process" described by Claim 1. This element is described in Claim 1 as follows:

> [A] server process executable on a processor communicatively coupled over the network to the client process...

The Examiner states this element is described in Hendrey (*i.e.*, Abstract; Figures 1 and 3; Column 7, lines 61-67; and Column 8, lines 1-49). However, these passages refer to a customer information database server 105 that is not the same as nor suggests the "server process" described by Claim 1. The database server 105 stores predetermined group lists 220 that are used by other portions of the telecommunications system disclosed in Hendrey to establish group connections. This description does not disclose the above claim element. Moreover, Claim 1 further describes the "server process" as:

> [T]he server process including an operation of sending a particular coupon to the client process...

This element can not be found in Hendry. In addition, the Examiner fails to provide any citations to Hendrey that describe this element and, thus, acknowledges that this element is not in Hendrey. Therefore, Hendrey does not disclose the "server process" as described in Claim 1.

Kubon similarly does not disclose nor suggest the aforementioned claim elements. Kubon does not even discuss two-way communication devices or coupons. Therefore, as the Examiner has already admitted, Kubon does not disclose nor suggest the aforementioned elements.

However, the Examiner argued that Kubon discloses the display screen claim element not found in Hendrey. The Examiner first admitted "Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image." (*See*, Office Action mailed April 21, 2004, at ¶ 4, p. 3.) Next, the Examiner argued the display screen is disclosed by Kubon (*i.e.*, by its Abstract, Figure 3 and Column 7, lines 13-41). This argument is unsupported and wrong. Claim 1 actually describes the display screen as a "display screen capable of displaying a barcode image suitable for scanning by a barcode scanner." Kubon does not disclose this "display screen." Instead, the sections cited by the Examiner discuss a "masking control" portion of Kubon's barcode image processing system. The "masking control" is not a display. Moreover, Kubon does not refer to barcode scanners and, therefore, cannot disclose this element of Claim 1.

Kubon contains other references to displays but none of them are the "display screen" described in Claim 1. For example, Kubon notes the image of a barcode label can be displayed on a video camera during the "masking control" process but does not state where on the camera the label is displayed. Kubon also describes a display monitor 420 but the display monitor is a typical display associated with a typical personal computer 400. (*See*, *e.g.*,

column 3, lines 5-20.) These displays are not the same as, nor equivalent to, the "display screen" of the two-way communication device as described in Claim 1. Moreover, Kubon discloses that the barcode image processing system reports data to a user through the personal computer (*see, e.g.*, Column 11, lines 14-19) but does not describe displaying barcode images on the display monitor 420. Therefore, Kubon does not disclose nor suggest the "screen display" of Claim 1.

The Examiner argues Hendrey discloses dependent Claim 7. This claim states, "the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers." However, as discussed above, the Hendrey passages cited by the Examiner (*i.e.,* Abstract; Figure 1; column 2, lines 40-67; column 5, lines 26-67; column 6, lines 1-67, specifically MUs 101a-c) do not disclose the "two-way communication device" described in Claim 1, on which Claim 7 depends. Therefore, Hendrey does not disclose nor suggest Claim 7.

The Examiner does not provide separate arguments as to how Hendrey or Kubon, individually or in combination, discloses or suggests dependent Claims 2-6 and 8-9 and, therefore, must be relying on the arguments outlined above. However, these arguments fail to prove these claims are rendered obvious by the references. These claims state:

> 2. A communication application according to Claim 1 further comprising:
>
> the client process including an operation for initiating a communication with the server process and requesting a first coupon for a selected item; and
>
> the server process including an operation for receiving the coupon request, determining whether the first a coupon is available, and, if so, transmitting the first coupon to the client process.
>
> 3. A communication application according to Claim 1 further comprising:

the client process including an operation for initiating a communication with the server process and requesting coupons for a generic class of items; and

the server process including an operation for receiving the coupon request, determining coupons that are available for items in the generic class, and transmitting resultant requested coupons to the client process.

4. A communication application according to Claim 1 further comprising:

the server process including an operation for profiling users to determine collections of items of interest to associated classes of users according to user profiles; and

the server process including an operation for sending one of the collections of items to one of the users in the associated class.

5. A communication application according to Claim 1 further comprising:

the server process including an operation responsive to a global positioning signal locating a user position, the operation for determining whether the user position is in a vicinity near a retailer honoring a first coupon in the coupon depository and, if so, sending the first coupon to the user.

6. A communication application according to Claim 1 wherein:

the barcode includes tracking information for tracking usage of the particular coupon.

8. An executable program code loadable from a storage media or downloadable from a communication source according to Claim 1.

9. An article of manufacture encoding the executable program code according to Claim 8.

None of the Examiner's arguments described above illustrates how Hendrey or Kubon describes or suggests these claim elements. Moreover, the Examiner does not provide any citations from

these references as evidence that either of them discloses these elements in stark violation of 37 C.F.R. § 1.104(c)(2). Therefore, Hendrey and Kubon, individually or in combination, do not disclose nor suggest these claims.

2. Claims 10-15

Hendrey and Kubon, individually or in combination, also do not disclose all the elements of Claims 10-15 as argued by the Examiner. Starting with Hendrey and Claim 10, the claim describes "a communication application executable on a network communicatively coupled to a server process." The claim states that "the communication application" comprises:

> [A] client process executable on a processor in a two-way communication device, the two-way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner, the client process including:
>
> an interactive input process capable of receiving input signals for the two-way communication device;
>
> a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network;
>
> a communication receiving process responsive to communication signals from the server process for receiving coupon information from the server process, the coupon information including an encoded barcode image; and
>
> a display process responsive to the receipt of the coupon information for decoding the encoded barcode image and displaying the barcode image.

Hendry does not disclose all these elements. For example, Claim 10 states, "the coupon information including an encoded barcode image." Hendrey does not refer to barcodes and therefore can not disclose this element. In addition, Hendrey's reference to e-coupons (*see*, Section B.1, *supra*) does not disclose this element. Moreover, Hendrey contains no suggestion that e-coupons be combined with barcodes. Furthermore, the Examiner has acknowledged that

Hendrey does not disclose a coupon including a barcode image. (*See*, Office Action mailed April 21, 2004, at ¶ 7.1, p. 7.) Therefore, Hendrey does not disclose nor suggest "the coupon information including an encoded barcode image" of Claim 10.

The Examiner also incorrectly argues that Hendrey discloses the "client process" of Claim 10. This claim describes the "client process" as:

> [A] client process executable on a processor in a two-way communication device, the two-way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner...

The Examiner states this element is described in Hendrey (*i.e.*, Abstract; Figure 1; Column 2, lines 40-67; Column 5, lines 26-67; Column 6, lines 1-67, specifically MUs101a-c). However, Hendrey does not contain any such description. Hendrey's brief reference to mobile telecommunication units (MUs) and telecommunication units (TUs) illustrates that they can be a mobile telephone, a personal digital assistant, a land line telephone and a personal computer. (*See, e.g.*, Figures 1 and 8.) However, these disclosures do not describe nor suggest a two-way communication device that includes a display screen capable of displaying a barcode image suitable for scanning via a barcode scanner. The lack of any reference to barcodes in Hendrey confirms this fact. Therefore, Hendrey does not disclose nor suggest this claim element.

The Examiner further incorrectly argues that Hendry discloses all the elements of the "client process" described in Claim 10. For example, the "client process" includes "an interactive input process" and "a communication initiating process" which are described by the claim as follows:

> [A]n interactive input process capable of receiving input signals for the two-way communication device,

> a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network...

The Examiner states these elements are described in Hendrey (*i.e.*, Abstract; Figures 1 and 3; Column 7, lines 61-67; column 8, lines 1-49). However, these passages refer to creating group connections between telecommunications units. This disclosure does not describe nor suggest the "interactive process" nor the "communication initiating process" that is part of the "client process." Therefore, Hendrey does not disclose nor suggest these claim elements.

The Examiner also incorrectly argues the "communication receiving process" of the "client process" in Claim 10 is disclosed by Hendrey. The claim describes the "communication receiving process" as follows:

> [A] communication receiving process responsive to communication signals from the server process for receiving coupon information from the server process...

The Examiner states this element is described in Hendrey (*i.e.*, column 15, lines 30-53, specifically scenario 1, database 143, e-coupons). However, these passages refer to a database 143 that contains store location and user information and does not state this database is a "communication receiving process" nor a "server process." Furthermore, the Examiner never cites any portion of Hendry that discloses "a server process" described in Claim 10. Therefore, Hendrey does not disclose nor suggest this claim element.

Kubon similarly does not disclose nor suggest the aforementioned claim elements. Kubon does not even discuss two-way communication devices or coupons. Therefore, as the Examiner has already admitted, Kubon does not disclose nor suggest the aforementioned elements.

However, the Examiner argues that Kubon discloses the display screen claim element not found in Hendrey. The Examiner admitted "Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image." (*See*, Office Action mailed April 21, 2004, at ¶ 4, p. 3.) Then, the Examiner argued the display screen is disclosed by Kubon (*i.e.*, by its Abstract, Figure 3 and Column 7, lines 13-41). This argument is unsupported and wrong. Claim 10 actually describes the display screen as a "display screen capable of displaying a barcode image suitable for scanning by a barcode scanner." Kubon does not disclose this "display screen." Instead, the sections cited by the Examiner discuss a "masking control" portion of Kubon's barcode image processing system. The "masking control" is not a display. Moreover, Kubon does not refer to barcode scanners and, therefore, cannot disclose this element of Claim 1.

Kubon contains other references to displays but none of them are the "display screen" described in Claim 10. For example, Kubon notes the image of a barcode label can be displayed on a video camera during the "masking control" process but does not state where on the camera the label is displayed. Kubon also describes a display monitor 420 but the display monitor is a typical display associated with a typical personal computer 400. (*See*, *e.g.*, column 3, lines 5-20.) These displays are not the same as, nor equivalent to, the "display screen" of the two-way communication device as described in Claim 10. Moreover, Kubon discloses that the barcode image processing system reports data to a user through the personal computer (*see, e.g.*, Column 11, lines 14-19) but does not describe displaying barcode images on the display monitor 420. Therefore, Kubon does not disclose nor suggest the "screen display" of Claim 10.

In addition, the Examiner fails to show how Kubon discloses the "display process" of Claim 1. The claim states the "client process" includes:

> [A] display process responsive to the receipt of the coupon information for decoding the encoded barcode image and displaying the barcode image

Therefore, Kubon does not disclose nor suggest the "display process" of Claim 10.

The Examiner argues Hendrey discloses dependent Claim 13. This claim states, "the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers." However, as discussed above, the Hendrey passages cited by the Examiner (*i.e.,* Abstract; Figure 1; column 2, lines 40-67; column 5, lines 26-67; column 6, lines 1-67, specifically MUs 101a-c) do not disclose the "two-way communication device" described in Claim 10, on which Claim 13 depends. Therefore, Hendrey does not disclose nor suggest Claim 13.

The Examiner does not provide separate arguments as to how Hendrey or Kubon, individually or in combination, discloses or suggests dependent Claims 11-12 and 14-15 and, therefore, must be relying on the arguments outlined above. However, these arguments fail to prove these claims are rendered obvious by the references. These claims state:

> 11. A communication application according to Claim 10 further comprising:
>
> a request process for requesting coupons for a generic class of items; wherein the communication receiving process receives coupon information of one or more coupons for items in the generic class.
>
> 12. A communication application according to Claim 10 further comprising:
>
> a request process for requesting coupons for a generic class of items; wherein

the communication receiving process receives coupon information of one or more coupons for items in the generic class; and the application further comprises

an interactive access process for displaying coupons, scrolling through coupons, and selecting coupons under direction of user signals.

13. A communication application according to Claim 10 wherein:

the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers.

14. An executable program code loadable from a storage media or downloadable from a communication source according to Claim 10.

15. An article of manufacture encoding the executable program code according to Claim 14.

None of the Examiner's arguments described above illustrates how Hendrey or Kubon describes or suggests these claim elements. Moreover, the Examiner does not provide any citations from these references as evidence that either of them discloses these elements in stark violation of 37 C.F.R. § 1.104(c)(2). Therefore, Hendrey and Kubon, individually or in combination, do not disclose nor suggest these claims.

3. Claims 16-22

Hendrey and Kubon, individually or in combination, do not disclose all the elements of Claims 16-22 as argued by the Examiner. Starting with Hendrey and Claim 16, the claim describes, "A communication application executable on a network comprising:"

[A]n electronic coupon clearinghouse coupled to the network and containing a plurality of electronic coupons, the electronic coupons including respective encoded barcode images;

a coupon database coupled to the electronic coupon clearinghouse;

> a server coupled to the network, the server capable of accessing the electronic coupon clearinghouse and receiving selected electronic coupons from the electronic coupon clearinghouse;
>
> a two-way communication device capable of communicating on the network and receiving electronic coupons from the server via the network, the two-way communication device capable of decoding the encoded barcode images and displaying the barcode images on a screen display.

The Examiner does not provide separate arguments regarding Claim 16 but lists Claim 16 with his arguments regarding Claim 10 even though Claim 16 does not describes the processes found in Claim 10. However, none of the Examiner's arguments regarding Claims 1 and 10 show that Hendrey discloses all the elements of Claim 16. For example, Claim 16 states, "the electronic coupons including respective encoded barcode images." Hendrey does not refer to barcodes and therefore can not disclose this element. In addition, Hendrey's reference to e-coupons (*see*, Section B.1, *supra*) does not disclose this element. Moreover, Hendrey contains no suggestion that e-coupons may be combined with barcodes. Furthermore, the Examiner has acknowledged that Hendrey does not disclose a coupon including a barcode image. (*See*, Office Action mailed April 21, 2004, at ¶ 7.1, p. 7.) Therefore, Hendrey does not disclose nor suggest "the electronic coupons including respective encoded barcode images" of Claim 16.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses, "an electronic coupon clearinghouse coupled to the network and containing a plurality of electronic coupons," and "a coupon database coupled to the electronic coupon clearinghouse." In connection with Claim 1, the Examiner asserts that Hendrey (*i.e.*, Column 15, lines 30-53) discloses "a coupon despository." However, this passage describes a database 143 that contains locations of historical, cultural or other importance, such as particular types of restaurants, coffee shops, snack shops or other businesses. (*See*, column 15, lines 35-37, 47-48;

Figure 8.) Hendrey does not specify database 143 is an electronic coupon clearinghouse coupled to a network and capable of storing a plurality of coupons nor specify database 143 is a coupon database. Hendrey's reference to e-coupons being sent to a mobile user does not provide the missing disclosure especially since the rest of Hendrey does not specify where the e-coupons are stored. (*See*, column 15, lines 41-46.) Moreover, Hendrey does not suggest the e-coupons are stored in database 143 or in any other database described in Hendrey. Therefore, Hendrey does not disclose nor suggest the aforementioned elements from Claim 16.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses the "server" and "two-way communication device" described in Claim 16. Claim 16 states:

> [A] server coupled to the network, the server capable of accessing the electronic coupon clearinghouse and receiving selected electronic coupons from the electronic coupon clearinghouse;
>
> a two-way communication device capable of communicating on the network and receiving electronic coupons from the server via the network, the two-way communication device capable of decoding the encoded barcode images and displaying the barcode images on a screen display.

In connection with Claim 1, the Examiner argues a "server process" is disclosed by Hendrey (*i.e.*, Abstract, Figures 1 and 3; column 7, lines 61-67; column 8, lines 1-49). However, the aforementioned passages refer to a customer information database server 105 that is not the same as nor suggests the "server" described by Claim 16. The database server 105 stores predetermined group lists 220 that are used by other portions of the telecommunications system disclosed in Hendrey to establish group connections. This description does not disclose the above claim elements. In addition, the Examiner never provides any citations to Hendrey to show that the reference discloses a two-way communication device that is capable of decoding a

barcode images that is encoded in a coupon sent to the device and is capable of displaying the barcode image on the device's screen. Therefore, Hendrey does not disclose nor suggest the aforementioned claim elements.

Kubon similarly does not disclose nor suggest the aforementioned claim elements. Kubon does not even discuss two-way communication devices or coupons. Therefore, as the Examiner has already admitted, Kubon does not disclose nor suggest the aforementioned elements.

However, the Examiner argues that Kubon discloses the display screen claim element not found in Hendrey. The Examiner admitted "Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image." (*See*, Office Action mailed April 21, 2004, at ¶ 4, p. 3.) Then, the Examiner argued the display screen is disclosed by Kubon (*i.e.*, by its Abstract, Figure 3 and Column 7, lines 13-41). This argument is unsupported and wrong. Claim 16 actually describes "a display screen" on which the two-way communication device displays decoded barcode images. Kubon does not disclose this "display screen." Instead, the sections cited by the Examiner discuss a "masking control" portion of Kubon's barcode image processing system. The "masking control" is not a display. Moreover, Kubon does not refer to barcode scanners and, therefore, cannot disclose this element of Claim 16.

Kubon contains other references to displays but none of them are the "display screen" described in Claim 16. For example, Kubon notes the image of a barcode label can be displayed on a video camera during the "masking control" process but does not state where on the camera the label is displayed. Kubon also describes a display monitor 420 but the display monitor is a typical display associated with a typical personal computer 400. (*See*, *e.g.*, column 3, lines 5-20.) These displays are not the same as, nor equivalent to, the "display screen"

of the two-way communication device as described in Claim 16. Moreover, Kubon discloses that the barcode image processing system reports data to a user through the personal computer (*see, e.g.*, Column 11, lines 14-19) but does not describe displaying barcode images on the display monitor 420. Therefore, Kubon does not disclose nor suggest the "screen display" of Claim 16.

The Examiner argues Hendrey discloses dependent Claim 22. This claim states, "the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers." However, as discussed above, the Hendrey passages cited by the Examiner (*i.e.*, Abstract; Figure 1; column 2, lines 40-67; column 5, lines 26-67; column 6, lines 1-67, specifically MUs 101a-c) do not disclose the "two-way communication device" described in Claim 16, on which Claim 22 depends. Therefore, Hendrey does not disclose nor suggest Claim 22.

The Examiner does not provide separate arguments as to how Hendrey or Kubon, individually or in combination, discloses or suggests dependent Claims 17-21 and, therefore, must be relying on the arguments outlined above. However, these arguments fail to prove these claims are rendered obvious by the references. These claims state:

> 17. A communication application according to Claim 16 further comprising:
>
> a profile engine coupled to the network and accessible by the server that generates user profiles and creates a collection of coupons according to the user profiles.
>
> 18. A communication application according to Claim 16 wherein:
>
> the two-way communication device initiates communication with the server and requests a particular coupon for a specific item; and

the server determines whether the particular coupon for the specific item is available in the coupon database and, if so, sends the particular coupon to the two-way communication device.

19. A communication application according to Claim 16 wherein:

the two-way communication device initiates communication with the server and requests coupons for a class of items: and

the server searches the coupon database for coupons included within the class of items and sends any results to the two-way communication device.

20. A communication application according to Claim 16 further comprising:

a profile engine coupled to the network and accessible by the server that generates user profiles and creates a collection of coupons according to the user profiles, wherein

the server periodically searches the coupon database for coupons included within the collection of coupons for a particular user profile and sends any resultant coupons in the collection to the two-way communication device.

21. A communication application according to Claim 16 wherein:

the server is responsive to a global positioning signal locating a user position by determining whether the user position is in a vicinity near a retailer honoring a particular coupon in the coupon depository and, if so, sending the particular coupon to the user.

None of the Examiner's arguments described above illustrates how Hendrey or Kubon describes or suggests these claim elements. Moreover, the Examiner does not provide any citations from these references as evidence that either of them discloses these elements in stark violation of 37

C.F.R. § 1.104(c)(2). Therefore, Hendrey and Kubon, individually or in combination, do not disclose nor suggest these claims.

4. Claims 23-27

Hendrey and Kubon, individually or in combination, do not disclose nor suggest all the elements of Claims 23-27. Starting with Hendrey and Claim 23, the claim describes, "A system for providing a user of a two-way communication device with an electronic coupon." The claim states the system comprises:

> [A] network;
>
> a two-way communication device connected to and forming at least part of the network, the two-way communication device including a display;
>
> a server connected to and forming at least part of the network;
>
> a coupon depository connected to the server, the coupon depository storing a plurality of coupons, at least some of the coupons including an associated barcode image; wherein
>
> the server is effective to forward select coupons and associated barcode images to the two-way communication device; and
>
> the two-way communication device is effective to receive the select coupons and associated barcode images and display the barcode images on the display.

The Examiner does not provide separate arguments regarding Claim 23 but lists Claim 23 with his arguments regarding Claim 10 even though Claim 23 does not describes the processes found in Claim 10. However, none of the Examiner's arguments regarding Claims 1 and 10 show that Hendrey discloses all the other elements of Claim 23. For example, Claim 23 states, "at least some of the coupons including an associated barcode image." Hendrey does not refer to barcodes and therefore can not disclose this element. In addition, Hendrey's reference to e-coupons (*see*, Section B.1, *supra*) does not disclose this element. Moreover, Hendrey contains

no suggestion that e-coupons be combined with barcodes. Furthermore, the Examiner has acknowledged that Hendrey does not disclose a coupon including a barcode image. (*See*, Office Action mailed April 21, 2004, at ¶ 7.1, p. 7.) Therefore, Hendrey does not disclose nor suggest "at least some of the coupons including an associated barcode image" of Claim 23.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses, "a coupon depository connected to the server, the coupon depository storing a plurality of coupons." In connection with Claim 1, the Examiner asserts that Hendrey (*i.e.*, Column 15, lines 30-53) discloses "a coupon despository." However, this passage describes a database 143 that contains locations of historical, cultural or other importance, such as particular types of restaurants, coffee shops, snack shops or other businesses. (*See*, column 15, lines 35-37, 47-48; Figure 8.) Hendrey does not specify database 143 is a coupon depository connected to a server and capable of storing a plurality of coupons. Hendrey's reference to e-coupons being sent to a mobile user does not provide the missing disclosure especially since the rest of Hendrey does not specify where the e-coupons are stored. (*See*, column 15, lines 41-46.) Moreover, Hendrey does not suggest the e-coupons are stored in database 143 or in any other database described in Hendrey. Therefore, Hendrey does not disclose nor suggest the aforementioned element from Claim 23.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses the other elements of Claim 23. Claim 23 states:

> [A] network;
>
> a two-way communication device connected to and forming at least part of the network, the two-way communication device including a display;
>
> a server connected to and forming at least part of the network...wherein

> the server is effective to forward select coupons and associated barcode images to the two-way communication device; and
>
> the two-way communication device is effective to receive the select coupons and associated barcode images and display the barcode images on the display.

As shown above, none of the Examiner's arguments describe a network that is formed in part by a server and a two-way communication device. In addition, none of his arguments describes a server forwarding selected coupons with associated barcode images that are displayed on the two-way communication device's display. Therefore, Hendrey does not disclose nor suggest the above claim elements.

Kubon similarly does not disclose nor suggest the aforementioned claim elements. Kubon does not even discuss two-way communication devices or coupons. Therefore, as the Examiner has already admitted, Kubon does not disclose nor suggest the aforementioned elements.

However, the Examiner argues that Kubon discloses the display screen claim element not found in Hendrey. The Examiner admitted "Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image." (*See*, Office Action mailed April 21, 2004, at ¶ 4, p. 3.) Then, the Examiner argued the display screen is disclosed by Kubon, (*i.e.*, by its Abstract, Figure 3 and Column 7, lines 13-41). This argument is unsupported and wrong. Claim 23 actually describes "a display" on which the two-way communication device displays decoded barcode images. Kubon does not disclose this "display screen." Instead, the sections cited by the Examiner discuss a "masking control" portion of Kubon's barcode image processing system. The "masking control" is not a display. Moreover, Kubon does not refer to barcode scanners and, therefore, cannot disclose this element of Claim 23.

Kubon contains other references to displays but none of them are the "display screen" described in Claim 23. For example, Kubon notes the image of a barcode label can be displayed on a video camera during the "masking control" process but does not state where on the camera the label is displayed. Kubon also describes a display monitor 420 but the display monitor is a typical display associated with a typical personal computer 400. (*See, e.g.*, column 3, lines 5-20.) These displays are not the same as, nor equivalent to, the "display screen" of the two-way communication device as described in Claim 23. Moreover, Kubon discloses that the barcode image processing system reports data to a user through the personal computer (*see, e.g.*, Column 11, lines 14-19) but does not describe displaying barcode images on the display monitor 420. Therefore, Kubon does not disclose nor suggest the "screen display" of Claim 23.

The Examiner does not provide separate arguments as to how Hendrey or Kubon, individually or in combination, discloses or suggests dependent Claims 24-27 and, therefore, must be relying on the arguments outlined above. However, these arguments fail to prove these claims are rendered obvious by the references. These claims state:

24. The system as recited in claim 23, wherein:

    the two-way communication device is effective to forward a request to the server for a particular coupon; and

    the server is effective to search the coupon depository and forward the particular coupon to the two-way communication device when the particular coupon is stored in the coupon depository.

25. The system as recited in claim 23, wherein the server is effective to forward a particular coupon to the two-way communication device based on a user profile.

26. The system as recited in claim 23, wherein:

the two-way communication device further generates a global positioning signal; and

the server is effective to read the global positioning signal and to forward a particular coupon to the two-way communication device based on the global positioning signal.

27. The system as recited in claim 23, wherein the two-way communication device is one of a cell phone, a pager, and a palm-held computer.

None of the Examiner's arguments described above illustrates how Hendrey or Kubon describes or suggests these claim elements. Moreover, the Examiner does not provide any citations from these references as evidence that either of them discloses these elements in stark violation of 37 C.F.R. 1.104(c)(2). Therefore, Hendrey and Kubon, individually or in combination, do not disclose nor suggest these claims.

5. Claims 28-32

Hendrey and Kubon, individually or in combination, do not disclose nor suggest all the elements of Claims 28-32. Starting with Hendrey and Claim 28, the claim describes, "A method for providing a user of a two-way communication device in a network with an electronic coupon, the network including a server and a coupon depository connected thereto, the coupon depository storing a plurality of coupons, at least some of the coupons including an associated barcode image, the two-way communication device including a display." The claim states the method comprises:

forwarding select coupons and associated barcode images to the two-way communication device from the server;

receiving the select coupons and associated barcode images at the two-way communication device; and

displaying the barcode images on the display.

The Examiner does not provide separate arguments regarding Claim 28 but lists Claim 28 with his arguments regarding Claim 10 even though Claim 28 does not describes the processes found in Claim 10. However, none of the Examiner's arguments regarding Claims 1 and 10 show that Hendrey discloses all the other elements of Claim 28. For example, Claim 28 states, "at least some of the coupons including an associated barcode image." Hendrey does not refer to barcodes and therefore can not disclose this element. In addition, Hendrey's reference to e-coupons (*see*, Section B.1, *supra*) does not disclose this element. Moreover, Hendrey contains no suggestion that e-coupons be combined with barcodes. Furthermore, the Examiner has acknowledged that Hendrey does not disclose a coupon including a barcode image. (*See*, Office Action mailed April 21, 2004, at ¶ 7.1, p. 7.) Therefore, Hendrey does not disclose nor suggest "at least some of the coupons including an associated barcode image" of Claim 28.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses, "a coupon depository" that is connected to a network and that "stor[es] a plurality of coupons." In connection with Claim 1, the Examiner asserts that Hendrey (*i.e.*, Column 15, lines 30-53) discloses "a coupon despository." However, this passage describes a database 143 that contains locations of historical, cultural or other importance, such as particular types of restaurants, coffee shops, snack shops or other businesses. (*See*, column 15, lines 35-37, 47-48; Figure 8.) Hendrey does not specify database 143 is a coupon depository connected to a network and capable of storing a plurality of coupons. Hendrey's reference to e-coupons being sent to a mobile user does not provide the missing disclosure especially since the rest of Hendrey does not specify where the e-coupons are stored. (*See*, column 15, lines 41-46.) Moreover, Hendrey does not suggest the e-coupons are stored in database 143 or in any other database

described in Hendrey. Therefore, Hendrey does not disclose nor suggest the above elements from Claim 28.

The Examiner's arguments regarding Claims 1 and 10 also do not show how Hendrey discloses the other elements of Claim 28. Claim 28 states:

> A method for providing a user of a two-way communication device in a network with an electronic coupon, the network including a server...the two-way communication device including a display, the method comprising:
>
> forwarding select coupons and associated barcode images to the two-way communication device from the server;
>
> receiving the select coupons and associated barcode images at the two-way communication device; and
>
> displaying the barcode images on the display.

As shown above, none of the Examiner's arguments describe a method that includes the forwarding, receiving and displaying steps described above. In addition, none of his arguments describes a step of forwarding select coupons with associated barcode images that are displayed on the two-way communication device's display. Therefore, Hendrey does not disclose nor suggest the above claim elements.

Kubon similarly does not disclose nor suggest the aforementioned claim elements. Kubon does not even discuss two-way communication devices or coupons. Therefore, as the Examiner has already admitted, Kubon does not disclose nor suggest the aforementioned elements.

However, the Examiner argues that Kubon discloses the display screen claim element not found in Hendrey. The Examiner admitted "Hendrey fails to explicitly disclose a display screen capable of displaying a barcode image." (*See*, Office Action mailed April 21, 2004, at ¶ 4, p. 3.) Then, the Examiner argued the display screen is disclosed by Kubon (*i.e.*, by

its Abstract, Figure 3 and Column 7, lines 13-41). This argument is unsupported and wrong. Claim 23 actually describes "a display" on which the two-way communication device displays barcode images. Kubon does not disclose this "display screen." Instead, the sections cited by the Examiner discuss a "masking control" portion of Kubon's barcode image processing system. The "masking control" is not a display. Moreover, Kubon does not refer to barcode scanners and, therefore, cannot disclose this element of Claim 28.

Kubon contains other references to displays but none of them are the "display screen" described in Claim 1. For example, Kubon notes the image of a barcode label can be displayed on a video camera during the "masking control" process but does not state where on the camera the label is displayed. Kubon also describes a display monitor 420 but the display monitor is a typical display associated with a typical personal computer 400. (*See, e.g.*, column 3, lines 5-20.) These displays are not the same as, nor equivalent to, the "display screen" of the two-way communication device as described in Claim 28. Moreover, Kubon discloses that the barcode image processing system reports data to a user through the personal computer (*see, e.g.*, Column 11, lines 14-19) but does not describe displaying barcode images on the display monitor 420. Therefore, Kubon does not disclose nor suggest the "screen display" of Claim 28.

The Examiner does not provide separate arguments as to how Hendrey or Kubon, individually or in combination, discloses or suggests dependent Claims 29-32 and, therefore, must be relying on the arguments outlined above. However, these arguments fail to prove these claims are rendered obvious by the references. These claims state:

> 29. The method as recited in claim 28, further comprising:
>
> sending a request to the server from the two-way communication device for a particular coupon;

searching the coupon depository; and

forwarding the particular coupon to the two-way communication device when the particular coupon is stored in the coupon depository.

30. The method as recited in claim 28, further comprising forwarding a particular coupon to the two-way communication device based on a user profile.

31. The method as recited in claim 28, further comprising:

generating a global positioning signal at the two-way communication device;

reading the global positioning signal at the server; and

forwarding a particular coupon to the two-way communication device based on the global positioning signal.

32. The method as recited in claim 28, wherein the two-way communication device is one of a cell phone, a pager, and a palm-held computer.

None of the Examiner's arguments described above illustrates how Hendrey or Kubon describes or suggests these claim elements. Moreover, the Examiner does not provide any citations from these references as evidence that either of them discloses these elements in stark violation of 37 C.F.R. § 1.104(c)(2). Therefore, Hendrey and Kubon, individually or in combination, do not disclose nor suggest these claims.

In sum, neither Hendrey nor Kubon, individually or in combination, disclose or suggest all of the claim elements. For example, neither reference discloses or suggests a coupon with an encoded barcode image. For this reason alone, the Examiner's rejections should be reversed. Therefore, the Board should reverse the Examiner's rejections.

C. The Examiner's Rejections of the Claims Should be Reversed Since Neither Hendrey Nor Kubon Contain Any Motivation To Combine One With the Other

The Examiner's assertions regarding why Hendrey should be combined with Kubon are incorrect and fail to show a motivation to combine the references. The Examiner's sole reason for combining these references is:

> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the mobile communications of Hendrey by including the limitation detailed above as taught by Kubon because *such modification would verify and report unauthorized users within the telecommunication network.*

(Office Action mailed April 21, 2004, ¶ 5, pages 3 and 5 (emphasis supplied).) This statement is not supported by Hendrey nor Kubon. Hendrey discloses a system for connecting mobile users based on physical proximity and Kubon discloses a system for processing and quality checking barcode labels. Neither of these references refers to nor suggests reporting unauthorized users within a telecommunication network. Thus, the Examiner's statement is incomprehensible as well as incorrect. Moreover, the Examiner fails to indicate why verifying and reporting unauthorized users within a telecommunication network relates to combining coupons with a barcode imaging system. In addition, the Examiner fails to provide and does not point to any disclosure within Hendrey or Kubon to support his incomprehensible assertion.

Furthermore, Hendrey and Kubon relate to different problems and different technologies that one of ordinary skill in the art would not necessarily combine. Hendrey describes a method and system for connecting mobile users in a telecommunications network based on their physical proximity. Kubon discloses a system and method for processing barcode images to check their quality. One of ordinary skill in the art in the telecommunications area and one of ordinary skill in the art in the barcode imaging processing area would not look to either

Hendrey or Kubon to arrive at the inventions as claimed in the present application. In addition, the barcode image processing system of Kubon is designed for a video camera and personal computer, which are not mobile telecommunications units as described in Hendrey. One of ordinary skill in the art with respect to either reference would readily understand that one cannot take the barcode image processing system of Kubon and readily insert it into a telecommunications unit of Hendrey without extreme modifications and experimentation. Moreover, one of ordinary skill in the art would readily understand that a telecommunications unit of Hendrey would not have the memory or processing power to act as a barcode image processing system as described in Kubon. Therefore, Hendrey and Kubon do not disclose nor suggest any motivation to combine one reference with the other. Accordingly, the Examiner's rejections should be reversed.

The Examiner's discussion of case law regarding motivation to combine further highlights the inappropriateness of his rejection. In the Office Action dated April 21, 2004, the Examiner restated his rejections from a prior office action and noted that the Applicant's arguments filed on January 27, 2004, had been fully considered but were not persuasive. (*See*, Office Action mailed April 21, 2004, ¶ 6, page 6.) In addition, the Examiner added several remarks including citations to several cases regarding the motivation to combine requirement of an obviousness analysis. The Examiner acknowledges that he must show a teaching, suggestion or motivation to combine the references in order to show that the combined references render the claims obvious. The Examiner cites several cases for the propositions that the motivation can be found in the references themselves, in knowledge generally available to one of ordinary skill in the art, or reasoned from knowledge generally available to one of ordinary skill in the art, from established scientific principles or from legal precedent. The Examiner also notes that his

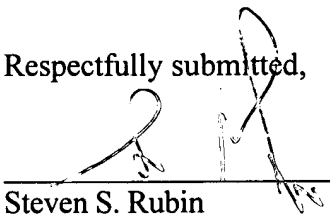
explanation can be based on logic and sound, scientific reasoning that will support a holding of obviousness. However, as discussed at length above, the Examiner has failed to show any motivation to combine based on the aforementioned principles. The Examiner does not show that the prior art references explicitly recite a motivation to combine, that one of ordinary skill in the art would generally know to combine these references, or that one of ordinary skill in the art would reason from knowledge generally available, from established scientific principles or from legal precedent to combine the references. Moreover, the Examiner does not provide any explanation based on logic or sound scientific reasoning to support his assertion. In view of the Examiner's failure, the Board should reverse Examiner's rejections.

VIII. CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Board reverse the rejections of Claims 1-32 as set forth in the Office Action mailed April 21, 2004, that the Board allow the pending claims since they are in condition for allowance, and that the Board grant any other relief as it deems proper.

Dated: February 22, 2005

Respectfully submitted,



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Annette Mejia — 2/22/05
Annette Mejia — Date

Appendix A
to
Appeal Brief
Serial No. 10/022,149
Attorney Docket No. 5598/44 US

Claims:

1. (Previously Amended) A communication application executable on a network comprising:

a client process executable on a processor in a two-way communication device, the two way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner;

a server process executable on a processor communicatively coupled over the network to the client process; and

a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image, the server process including an operation of sending a particular coupon to the client process, the client process including an operation for decoding the respective barcode image encoding corresponding to the particular coupon and displaying the respective barcode image on the display screen.

2. (Previously Amended) A communication application according to Claim 1 further comprising:

the client process including an operation for initiating a communication with the server process and requesting a first coupon for a selected item; and

the server process including an operation for receiving the coupon request, determining whether the first a coupon is available, and, if so, transmitting the first coupon to the client process.

3. (Previously Amended) A communication application according to Claim 1 further comprising:

the client process including an operation for initiating a communication with the server process and requesting coupons for a generic class of items; and

the server process including an operation for receiving the coupon request, determining coupons that are available for items in the generic class, and transmitting resultant requested coupons to the client process.

4. (Previously Amended) A communication application according to Claim 1 further comprising:

the server process including an operation for profiling users to determine collections of items of interest to associated classes of users according to user profiles; and

the server process including an operation for sending one of the collections of items to one of the users in the associated class.

5. (Previously Amended) A communication application according to Claim 1 further comprising:

the server process including an operation responsive to a global positioning signal locating a user position, the operation for determining whether the user position is in a vicinity near a retailer honoring a first coupon in the coupon depository and, if so, sending the first coupon to the user.

6. (Previously Amended) A communication application according to Claim 1 wherein:

the barcode includes tracking information for tracking usage of the particular coupon.

7. (Original) A communication application according to Claim 1 wherein:

the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers.

8. (Original) An executable program code loadable from a storage media or downloadable from a communication source according to Claim 1.

9. (Original) An article of manufacture encoding the executable program code according to Claim 8.

10. (Previously Amended) A communication application executable on a network communicatively coupled to a server process, the communication application comprising:

a client process executable on a processor in a two-way communication device, the two-way communication device including a display screen capable of displaying a barcode image suitable for scanning by a barcode scanner, the client process including:

an interactive input process capable of receiving input signals for the two-way communication device;

a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network;

a communication receiving process responsive to communication signals from the server process for receiving coupon information from the server process, the coupon information including an encoded barcode image; and

a display process responsive to the receipt of the coupon information for decoding the encoded barcode image and displaying the barcode image.

11. (Previously Amended) A communication application according to Claim 10 further comprising:

a request process for requesting coupons for a generic class of items; wherein the communication receiving process receives coupon information of one or more coupons for items in the generic class.

12. (Previously Amended) A communication application according to Claim 10 further comprising:

a request process for requesting coupons for a generic class of items; wherein

the communication receiving process receives coupon information of one or more coupons for items in the generic class; and the application further comprises

an interactive access process for displaying coupons, scrolling through coupons, and selecting coupons under direction of user signals.

13. (Original) A communication application according to Claim 10 wherein:

the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers.

14. (Original) An executable program code loadable from a storage media or downloadable from a communication source according to Claim 10.

15. (Original) An article of manufacture encoding the executable program code according to Claim 14.

16. (Currently Amended) A communication application executable on a network comprising:

an electronic coupon clearinghouse coupled to the network and containing a plurality of electronic coupons, the electronic coupons including respective encoded barcode images;

a coupon database coupled to the electronic coupon clearinghouse;

a server coupled to the network, the server capable of accessing the electronic coupon clearinghouse and receiving selected electronic coupons from the electronic coupon clearinghouse;

a two-way communication device capable of communicating on the network and receiving electronic coupons from the server via the network, the two-way communication

device capable of decoding the encoded barcode images and displaying the barcode images on a screen display.

17. (Previously Amended) A communication application according to Claim 16 further comprising:

a profile engine coupled to the network and accessible by the server that generates user profiles and creates a collection of coupons according to the user profiles.

18. (Previously Amended) A communication application according to Claim 16 wherein:

the two-way communication device initiates communication with the server and requests a particular coupon for a specific item; and

the server determines whether the particular coupon for the specific item is available in the coupon database and, if so, sends the particular coupon to the two-way communication device.

19. (Previously Amended) A communication application according to Claim 16 wherein:

the two-way communication device initiates communication with the server and requests coupons for a class of items: and

the server searches the coupon database for coupons included within the class of items and sends any results to the two-way communication device.

20. (Previously Amended) A communication application according to Claim 16 further comprising:

a profile engine coupled to the network and accessible by the server that generates user profiles and creates a collection of coupons according to the user profiles, wherein

the server periodically searches the coupon database for coupons included within the collection of coupons for a particular user profile and sends any resultant coupons in the collection to the two-way communication device.

21. (Previously Amended) A communication application according to Claim 16 wherein:

the server is responsive to a global positioning signal locating a user position by determining whether the user position is in a vicinity near a retailer honoring a particular coupon in the coupon depository and, if so, sending the particular coupon to the user.

22. (Original) A communication application according to Claim 16 wherein:

the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers.

23. (Previously Presented) A system for providing a user of a two-way communication device with an electronic coupon, the system comprising:

a network;

a two-way communication device connected to and forming at least part of the network, the two-way communication device including a display;

a server connected to and forming at least part of the network;

a coupon depository connected to the server, the coupon depository storing a plurality of coupons, at least some of the coupons including an associated barcode image; wherein

the server is effective to forward select coupons and associated barcode images to the two-way communication device; and

the two-way communication device is effective to receive the select coupons and associated barcode images and display the barcode images on the display.

24. (Previously Presented) The system as recited in claim 23, wherein:

the two-way communication device is effective to forward a request to the server for a particular coupon; and

the server is effective to search the coupon depository and forward the particular coupon to the two-way communication device when the particular coupon is stored in the coupon depository.

25. (Previously Presented) The system as recited in claim 23, wherein the server is effective to forward a particular coupon to the two-way communication device based on a user profile.

26. (Previously Presented) The system as recited in claim 23, wherein:

the two-way communication device further generates a global positioning signal; and

the server is effective to read the global positioning signal and to forward a particular coupon to the two-way communication device based on the global positioning signal.

27. (Previously Presented) The system as recited in claim 23, wherein the two-way communication device is one of a cell phone, a pager, and a palm-held computer.

28. (Previously Presented) A method for providing a user of a two-way communication device in a network with an electronic coupon, the network including a server and a coupon depository connected thereto, the coupon depository storing a plurality of coupons, at least some of the coupons including an associated barcode image, the two-way communication device including a display, the method comprising:

forwarding select coupons and associated barcode images to the two-way communication device from the server;

receiving the select coupons and associated barcode images at the two-way communication device; and

displaying the barcode images on the display.

29. (Previously Presented) The method as recited in claim 28, further comprising:

sending a request to the server from the two-way communication device for a particular coupon;

searching the coupon depository; and

forwarding the particular coupon to the two-way communication device when the particular coupon is stored in the coupon depository.

30. (Previously Presented) The method as recited in claim 28, further comprising forwarding a particular coupon to the two-way communication device based on a user profile.

31. (Previously Presented) The method as recited in claim 28, further comprising:

generating a global positioning signal at the two-way communication device;

reading the global positioning signal at the server; and

forwarding a particular coupon to the two-way communication device based on the global positioning signal.

32. (Previously Presented) The method as recited in claim 28, wherein the two-way communication device is one of a cell phone, a pager, and a palm-held computer.